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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,767	02/26/2001	David Edwin Thurston	65435-9002	6332

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,767

Applicant(s)

THURSTON ET AL.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12,13,15-21,25-27,29,32-38,40,42,46-60 and 62-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,15-21,25-27,29,32-34,40,47-49,57-60,63 and 65 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-10,38,42,46,50-56 and 64 is/are rejected.
- 7) ☒ Claim(s) 6,12,35-37 and 62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/26/01 & 8/28/02 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claims 1, 3-10, 12, 13, 15-21, 25-27, 29, 32-38, 40, 42, 46-60 and 62-65 are pending in the application.

This action is in response to applicants' amendment filed April 14, 2004. Claims 1, 25-27, 33, 42, 50, 56 and 62 have been amended.

Response to Amendment

Applicants' arguments filed April 14, 2004 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the obviousness-type double patenting rejection claims 1, 3-7, 20, 21, 25-27, 29, 32-38, 40, 42, 46, 48-56, 60, 63 and 65, labeled paragraph 1 in the last office action, which is hereby **withdrawn**.
2. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 102 anticipation rejection of claims 50-55 labeled paragraph 2 in the last office action, which is hereby **withdrawn**.
3. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 1, 3-5, 7-10, 38, 42 and 46 labeled paragraph 4 in the last office action, the applicants' arguments have been fully considered but are not found persuasive. The applicants' stated that they have amended claim 1 to state that the proviso applies to formula Ia only, as shown at page 3, lines 24-28. However, there is no positive recitation for formula Ia or Ib in the specification for the definition of R₂ where R₂ is CH=CR^AR^B, where R^A and R^B are independently selected from H, R^C, COR^C, CONH₂, CONHR^C, CONR^C₂, cyano or phosphonate, where R^C

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is an unsubstituted alkyl group having 1 to 4 carbon atoms. The negative limitation described at page 3, lines 24-28 is for compounds of formula Ia and does not set forth a statement of utility for the compounds of formula Ib where R_2 is $CH=CR^A R^B$, where R^A and R^B are independently selected from H, R^C , COR^C , $CONH_2$, $CONHR^C$, $CONR^C_2$, cyano or phosphonate, where R^C is an unsubstituted alkyl group having 1 to 4 carbon atoms. The implication that R_2 is $CH=CR^A R^B$ for all other permutation claimed herein are not enabled.

Claims 1, 3-5, 7-10, 38, 42 and 46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such as a way as to reasonably convey to one skilled in the relevant art that the inventors), at the time the application was filed, had possession of the claimed invention, for reasons of record and stated above.

4. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 26 and 27, labeled paragraph 8) in the last office action, which are hereby **withdrawn**.

5. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of claim 56, labeled paragraph 9) in the last office action, which is hereby **withdrawn**.

6. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 25, 33 and 62, labeled paragraph 10a), b) and d) in the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 10c) the

applicant's amendments and remarks have been fully considered but they are not persuasive. The applicants' stated that the applicants have amended claim 42 to delete "la" and "lb". However, while it is noted that "la" and "lb" were deleted with respect to the structures, there is still reference to formula la and lb in the second line of the claim.

Claim 42 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

7. The applicants' amendments and arguments are sufficient to overcome the obviousness-type double patenting rejection claims 38, 50-55 and 64, labeled paragraph 11 in the last office action, which is hereby **withdrawn**.

8. With regards to the provisional obviousness-type double patenting rejection as being unpatentable over copending Application No. 10/021,213 of the last office action, the applicants requested that this rejection be held in abeyance at this time.

Claims 38, 50-55 and 64 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/021,213, for reasons of record.

In view of the amendment dated April 14, 2004, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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9. Claims 56 and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

- a) Claims 56 and 64 are vague and indefinite in that it is not known if they are complete or not since they do not end with a period.

Claim Objections

10. Claims 6, 12, 35-37 and 62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

11. Claims 13, 15-21, 25-27, 29, 32-34, 40, 47-49, 57-60, 63 and 65 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds, compositions or method of use of the compounds of formulae II, III, IV as claimed herein.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened


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statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brenda Coleman
Primary Examiner Art Unit 1624
August 3, 2004